

CUSTOMER NO.: 24498

Serial No. 09/963,244

RCE - Reply to Final Office Action dated: 1/07/05

Preliminary Amendment dated: 02/18/05

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PU010200*BEST AVAILABLE COPY*REMARKS

In the Final Office Action, the Examiner noted that claims 1-10 and 12-21 are pending in the application and that claims 1-10 and 12-21 stand rejected. By this response claim 2 has been cancelled, claims 23 and 24 have been added and claims 1, 3, 12, 15 and 19-21 have been amended to more clearly define the Applicant's invention and not in response to prior art. All other claims are unamended by this response.

In view of the amendments presented above and the following discussion, the Applicant respectfully submits that none of these claims now pending in the application are anticipated under the provisions of 35 U.S.C. § 102. Thus the Applicant believes that all of these claims are now in allowable form.

Rejections**A. 35 U.S.C. § 102**

The Examiner rejected claims 1-10 and 12-21 under 35 U.S.C. § 102(b) as being anticipated by Ohara et al. (U.S. Patent 6,317,831, hereinafter "Ohara"). The rejection is respectfully traversed.

The Examiner alleges that in the Applicant's application, each of the independent claims is drawn to an alternative limitation "one or more of" and thus only one of the limitations is to be shown in order to meet the claimed invention. The Applicant would like to respectfully point out to the Examiner that the Applicant's amended independent claims are not drawn to an alternative limitation.

The Examiner further alleges that the Applicant's independent claims merely read on reading the medium and if an error has occurred than the error location is stored in a primary or secondary defective lists and that such limitation is inherently present in every optical disk media having a PDL and SDL storing the location of the defective segments on the disk. The Applicant respectfully disagrees.

"Anticipation requires the presence in a single prior art reference disclosure of **each and every element of the claimed invention, arranged as in the claim**" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1983)) (emphasis added).

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The Applicant respectfully submits that the Ohara reference fails to teach, suggest or disclose each and every element of at least the Applicant's invention as recited in at least the Applicant's amended, independent claim 1, which specifically recites:

"A method of detecting defects in a recordable optical storage medium, comprising the steps of:

accessing a portion of the recordable storage medium wherein new data is to be recorded;

in response to detecting old data having been previously recorded in said accessed portion, selectively examining the old data for defects prior to recording said new data; and

in response to detecting a lack of previously recorded data in said accessed portion, recording test data in said accessed portion and selectively examining the recorded test data for defects prior to recording said new data;

wherein if defects are detected in the data in said accessed portion, corrective measures are taken." (emphasis added).

The Applicant's invention is directed at least in part to a method and system for detecting defects in a recordable optical storage medium where at least a portion of the recordable storage medium in which new data is to be recorded is examined for defects. In the invention of the Applicant, if previously recorded data exists in the accessed portion, the old data is reproduced and examined for defects. If no previously recorded data exists in the accessed portion, test data is recorded in the accessed portion and the test data is reproduced and examined for defects. In the invention of the Applicant, if either the examined old data or the examined test data in the accessed portion of the storage medium exhibits defects, corrective measures are taken. In support of the Applicant's invention, at least as claimed by the Applicant's amended claim 1 recited above, the Applicant in the Specification, specifically recites:

"In one arrangement, the device 100 can be merely playing back multimedia data that has been recorded during a previous recording session. Alternatively, the device 100 can also be recording multimedia data, and the accessed segment of the multimedia data can be a segment of data that has just been recorded onto the disc 102. Once accessed, the front end processor 109 can selectively examine the segment of multimedia data to determine whether the first portion of the disc 102 from which the segment was read contains a defect" (See Applicant's Specification, page 10, lines 1-9). (emphasis added).

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The Applicant, in the Specification, further recites:

"In another arrangement, test data can be written onto at least a portion of the recordable storage medium prior to or during the step of writing the actual data to be recorded onto that portion of the medium. Specifically, a portion of the recordable storage medium can receive the test data. Once the test data is recorded onto the medium, the test data can then be selectively examined - similar to the examining process described above in step 214 - to determine whether the recording area contains one or more flaws." (See Applicant's Specification, page 16, lines 17-23).

In support of at least the Applicant's amended claim 1, the Applicant specifically teaches, as clearly depicted by at least the portions of the Applicant's Specification depicted above, a method for detecting defects in a recordable optical storage medium including "playing back multimedia data that has been recorded during a previous recording session" to determine whether an accessed portion of the storage medium contains a defect and alternatively "recording multimedia data" (test data) and examining "the segment of multimedia data to determine whether the first portion of the disc 102 from which the segment was read contains a defect." The Applicant specifically teaches that in one arrangement the multimedia data just recorded on the storage medium for purposes of determining whether a portion of the disk contains defects, is test data, all of which is claimed by at least the Applicant's amended claim 1.

The Applicant respectfully submits that there is absolutely no teaching, suggestion or disclosure in Ohara for a method and system for detecting defects in a recordable optical storage medium including at least "accessing a portion of the recordable storage medium wherein new data is to be recorded", "in response to detecting old data having been previously recorded in said accessed portion, selectively examining the old data for defects prior to recording said new data", and "in response to detecting a lack of previously recorded data in said accessed portion, recording test data in said accessed portion and selectively examining the recorded test data for defects prior to recording said new data" as taught in the Applicant's Specification and claimed by at least the Applicant's amended claim 1 and amended claim 12.

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In contrast to the teachings and the invention of the Applicant's as claimed by at least amended, independent claims 1 and 12, Ohara teaches an information recording/reproducing apparatus and a method of recording data onto an information recording/reproducing media. In Ohara, the information recording/reproducing apparatus has the capability of handling the information recording/reproducing media both when they are not in a case and when they are in a case. A recording mode is selected basing on the determinations of (i) whether or not the recording/reproducing medium is a medium type which is necessarily contained in a case at recording and (ii) whether the case is present or absent. (See Ohara, Abstract).

However, there is absolutely no teaching, suggestion or disclosure in Ohara for at least "accessing a portion of the recordable storage medium wherein new data is to be recorded" and "in response to detecting old data having been previously recorded in said accessed portion, selectively examining the old data for defects prior to recording said new data", and "in response to detecting a lack of previously recorded data in said accessed portion, recording test data in said accessed portion and selectively examining the recorded test data for defects prior to recording said new data" as taught in the Applicant's Specification and claimed by at least the Applicant's amended claim 1 and amended claim 12. Instead, in Ohara, upon a history determining means detecting the absence of an identification member, a user is offered an option whether or not to perform a verification mode. If a user opts to perform the verification mode, a verification means verifies newly recorded information that is intended to remain on a disc (i.e., not test data or previously recorded data examined before recording the new data that is intended to remain on a recordable storage medium as in the invention of the Applicant).

For at least the reasons described above, the Applicant respectfully submits that the teachings of Ohara fall far short of the Applicant's claimed invention, at least with respect to amended, independent claims 1 and 12.

As such and at least because the teachings of Ohara teach away from the invention of the Applicant and because Ohara fails to teach, suggest or disclose at least "accessing a portion of the recordable storage medium wherein new data is

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to be recorded", "in response to detecting old data having been previously recorded in said accessed portion, selectively examining the old data for defects prior to recording said new data", and "in response to detecting a lack of previously recorded data in said accessed portion, recording test data in said accessed portion and selectively examining the recorded test data for defects prior to recording said new data" as taught in the Applicant's Specification and claimed by at least the Applicant's amended claim 1, the Applicant respectfully submits that the teachings and disclosure of Ohara do not teach each and every element of the Applicant's claimed invention, arranged as in the claim, and as such, Ohara does not anticipate the Applicant's invention, at least with respect to amended, independent claim 1.

Therefore, the Applicant submits that for at least the reasons recited above, amended, independent claim 1 is not anticipated by the teachings of Ohara and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Likewise, amended, independent claim 12 recites similar relevant features as recited in the Applicant's independent claim 1. As such, the Applicant submits that for at least the reasons recited above, independent claim 12 is also not anticipated by the teachings of Ohara and also fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Furthermore, dependent claims 2-10, 13-21 and 23-24 depend either directly or indirectly from independent claims 1 and 12 and recite additional features therefor. As such and for at least the reasons set forth herein, the Applicant submits that dependent claims 2-10, 13-21 and 23-24 are also not anticipated by the teachings of Ohara. Therefore the Applicant submits that dependent claims 2-10, 13-21 and 23-24 also fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

The Applicant reserves the right to establish the patentability of each of the claims individually in subsequent prosecution.

Conclusion:

Thus the Applicant submits that none of the claims, presently in the application, are anticipated under the provisions of 35 U.S.C. § 102.

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Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion, it is respectfully requested that the Examiner telephone the undersigned.

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account No. 07-0832.

Respectfully submitted,
Mark Alan Schultz et al.

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